PATENT
Customer No. 22,852
Atty. Docket No.: 01142.0101

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Mark Henry PAUSCH *et al.*	)	Group Art Unit: 1647
	)	
Application No.: 09/786,056	)	Examiner: S. L. Wegert
	)	
International Filing Date: September 1, 1999	)	
	)	
For: ENHANCED FUNCTIONAL EXPRESSION OF G PROTEIN-COUPLED RECEPTORS	)	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In response to a restriction requirement mailed April 22, 2003, Applicants submit the following remarks in this request for reconsideration. In light of the concurrently filed petition for a four-month extension of time and appropriate fees, this response is due by September 22, 2003, and is timely filed.

The Office has issued a third restriction in this application. In the previous restriction requirement mailed on September 9, 2002, the Office asserted that the pending claims were directed to 10 separate and distinct inventions. Claims 13 and 16 were placed into Group II, which Applicants elected with traverse in their Amendment and Response filed February 7, 2003. In addition, Applicants requested entry of claims 52-85, which with the exception of claim 81, each depend from claims 13 and 26. All of the claims pending after entry of the Amendment (13, 26, and 52-85) are directed to a

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method of screening compounds that bind to a G protein-coupled receptor to cause cell growth. In other words, they are all directed to what the Office asserted constitutes Group II.

The Office has now further restricted the invention of Group II, purportedly in view of new claims 52-85. The Office contends that the claims do not form a single inventive concept under PCT Rule 13.1. Office action, page 2. The Office concludes that the claims constitute nine distinct inventions. *Id.*, pages 2-3. Applicants are required to elect a single invention for prosecution. *Id.*, page 2.

In response, Applicants elect to prosecute Group IX, claims 70-80, 82, 83, and 85 drawn to a method of screening compounds that bind to a G protein coupled-receptor in a host cell, with traverse. For Group IX, the Office also requires Applicants to elect one heterologous G-protein coupled receptor from the list set forth on pages 4 and 5 of the Office action. Applicants elect a human α2A adrenergic receptor, with traverse.

Applicants traverse for the following reasons. First, Applicants fail to understand how the Office can place claims 13 and 26 into the same group in the prior Office action, but in the instant Office action, assert that these claims fall into two distinct groups. Applicants amended claims 13 and 26 to convert them from dependent to independent claims, but did not add any additional limitations. How is it possible that the Office considers these claims as directed to the same invention in one instance but now asserts that these claims constitute distinct inventions when the claims recite the same language in both instances? Applicants submit there is no basis for treating these claims differently now than they were treated in the previous Office action. For this reason alone the Office should withdraw the instant restriction requirement.

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The Office appears to justify the new restriction requirement on the fact that "Applicants newly filed claims are drawn to several patentably distinct inventions." Office action, page 2. To the extent the Office is relying on entry of the dependent claims as justifying the instant restriction requirement, Applicants respectfully disagree. With the exception of claim 81, all of the new claims are dependent on claims 13 or 26.

Applicants submit that if independent claims 13 and 26 possess unity of invention as the Office determined in the Office action mailed September 9, 2002, then claims that depend from claims 13 and 26 must also possess unity of invention. In other words, if claims 13 and 26 recite a special technical feature then claims depending from them must also recite that feature. A dependent claim includes all of the limitations of the claim(s) from which it depends. The dependent claims, therefore, must also recite the special technical feature. The fact that the dependent claims recite additional aspects of the invention does not alter this conclusion. For this reason it is improper for the Office to now split claims 13 and 16 into separate groups.

Furthermore, by this reasoning it is also improper for the Office to place any of these claims into groups that do not include claims 13 and 16. Because all of the claims recite the special technical feature, there is unity of invention under PCT Rule 13.1. The Office should therefore examine all of the pending claims on the merits in this application.

As part of its reasoning purporting to support the requirement, the Office contends that the nine groups of claims each have independent utility. Office action, page 4. The utility of the claims is recited in the preamble: "[a] method for screening compounds capable of binding to G protein-coupled receptors . . . ." *See* claims 13, 26, and 81. All of the pending claims are directed to this method. None of the claims recite

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any other utility. Even if the claims in groups I-IX "can be used each independently" to study any of the listed items on page 4 of the Office action, that is not relevant to whether the claims possess unity of invention. Moreover, the Office asserts at page 4 that "the claimed methods are practiced . . . for materially different purposes . . . and goals," but this is incorrect. As is clear from the claim language, the goal of all of the methods is "screening for compounds capable of binding to G protein-coupled receptors . . ." Contrary to the Office's conclusions, all of the claims are directed to the same purpose.

In the context of the Office's further requirement to pick a single receptor that applies to groups V and IX, the Office asserts that each receptor type is distinct from the other because "they have different putative functions, different structures, and require completely different search terms." Office action, pages 5-6. Respectfully, the invention is not the receptor type used in the claimed methods. It is a method of screening compounds. The Office's requirement that a single receptor type be elected is improper as the receptor is not relevant to the issue of whether there is unity of invention. Accordingly, the Office should also withdraw this requirement.

Restriction of claims 13, 26, and 52-85 into nine groups and seventeen receptor types is inappropriate under the unity of invention standard of PCT Rule 13.1. Applicants respectfully request that the Office reconsider and withdraw the restriction of the pending claims in light of Applicants' remarks and the prior remarks of record. In the event that the Office does not withdraw this restriction requirement, Applicants request that the Office make it in the next Office action so they may file a petition for review of the requirement.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: September 22, 2003

By: _____

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